

REMARKS

In the Office Action mailed November 1, 2004, the Examiner rejected claims 1 and 3-30¹ under 35 U.S.C. § 102(e) as being anticipated by Mullins (U.S. Patent Application Publication 2002/0091702) and rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Mullins in view of Sidles (U.S. Patent Application Publication No. 2002/0062342).

Based on the following remarks, Applicants respectfully traverse the rejection of claims 1-30 under U.S.C. §§ 102(e) and 103(a).

I. The Examiner Still has not shown that Mullins is prior art under 35 U.S.C. §§ 102(e) and 103(a)

To qualify as prior art under 35 U.S.C. § 102(e), the "disclosure relied on in the rejection must be present in the ... application publication." See *MPEP* § 2136.02. Further, "[i]n order to carry back the 35 U.S.C. § 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must (A) have a right of priority to the earlier date under 35 U.S.C. 120 ... and (B) support the invention as claimed as required by 35 U.S.C. 112, first paragraph." See *MPEP* 2126.03 (IV) (citing, *inter alia*, Ex parte Gilderdale, 1990 Pat. App. LEXIS 25 (Bd. Pat. App. & Inter. Appeal no. 89-0352.) In Gilderdale, the Board reversed the rejection under 35 U.S.C. § 102(e) because the reference relied upon by the Examiner was

¹ Applicants note that the Examiner rejects claims 1-30 under 35 U.S.C. § 102(e) on page 2 of the Office Action, but did not address claim 2 in the body of the rejection. Instead, the Examiner rejects this claim under 35 U.S.C. § 103(a). Thus, Applicants assume that the rejection of claim 2 under 35 U.S.C. § 102(e) is inadvertent and therefore will not address this claim under that section of Title 35.

not entitled to the filing date of the CIP grandparent application because the “parent and child applications contained new mater as compared to the grandparent.” *Id.*

In this case, Mullins has a filing date of November 15, 2001. Applicants filing date is June 7, 2001, predating the filing date of Mullins. The reference, however, claims priority as a continuation-in-part of application no. 60/249,418, filed November 16, 2000. Accordingly, unless the parent ‘418 application supports the invention as claimed in Mullins, the priority date of November 16, 2000 cannot be relied upon by the Examiner to reject claims 1-30 under 35 U.S.C. §§102(e) or 103(a). Because Mullins is a CIP of the ‘418 application, there is new matter present in Mullins.

According to 37 C.F.R. § 1.104(c), the “pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” Because Mullins is a CIP of the ‘418 application, it is not apparent what subject matter disclosed in Mullins qualifies for the priority date of the ‘418 application. Accordingly, the Examiner has the initial burden to show the pertinence of this reference in rejecting claims 1-30, which includes specifying whether the subject matter relied upon by the Examiner in the rejections is not new matter.

To meet this burden, the Examiner asserts that Mullins contains “information which is not new matter as applied to applicant’s invention.” The Examiner supports this position based on the fact that “[t]he provisional application incorporates by reference U.S. Patent No. 5,857,197 (“the ‘197 patent”) and the appendices to the provisional of ‘Cocobase.” (See Office Action, page 13.) Because it is unclear which reference the Examiner is relying upon to reject claims 1-30, Applicants submit that

the Examiner has not properly articulated the basis for the rejection of these claims in view of Mullins.

a. The Portions of Mullins Cited by the Examiner Include New Matter in Relation to U.S. Patent No. 5,857,197.

In one interpretation, the above-referenced Examiner's comments may be viewed as the Examiner's belief that the portions of Mullins relied upon to reject claims 1-30 are not new matter in relation to the '197 patent. Applicant disagrees. For example, paragraphs [0045] and [0046] of Mullins, which are relied upon extensively by the Examiner, include new matter in relation to the '197 patent. For instance, paragraph [0045] of Mullins states with key phrases bolded for emphasis,

[0045] FIG. 3 is a diagram depicting the comprehensive operation of the present invention as described in FIG. 2, **further including a number of system components or connection points for additional components.** The wavy cloud that surrounds some of the system depicts the CocoBase components and the portion of the system that is called the Java environment. **The additional component that are shown in FIG. 3 beyond the components described in FIG. 2 are** (1) a CocoBase Object Access and Storage Adapter software module, (2) a CocoBase Object Model Repository (may be stored in a separate data source or in the system DataSource Relational Database), (3) a Plugin API (and optional caching database attached via the API) to the CocoBase Mapping Layer for caching one or more members of the group consisting of database data, query string(s), CocoBase Map(s), and data object(s), and (4) a CocoBase Dynamic Object/Relational Repository as a separate file, which could also be stored in the DataSource Relational DataBase.

Further, paragraph [0046] states with key phrases bolded for emphasis,

[0046] FIG. 4 is a diagram depicting the comprehensive operation of the present invention as described in FIG. 3, **further including a number of system components or connection points for additional components.** The **additional components shown are** (1) an CocoBase

Development Software module called CocoAdmin having command line and/or GUI interfaces for accessing, editing and creating new maps, for generating source code, for compiling object classes from source code, or for generating J2EE components such as EJBs from CocoBase maps, (2) one or both of a CocoBase CocoDriver Server, (3) Object Access and Storage Adapter for processing the storage of objects or object schema(s), which may access or process them in the form of objects for an object database, as a UML file for a UML modeling tool, or may convert the objects or object scheme to or from one or more of UML, XML or XMI format representations of such objects or object schema(s), (3) an optional CocoBase Object Model Repository file, which may be stored as stand alone files, in an Object or Relational data source, or an XML repository, and (4) an optional Object Modeling Tool Data File which can be exchanged between the CocoBase Tool Suite and the Object Modeling Tool in one or more directions, i.e., to the CocoBase tool suite, from the CocoBase tool suite, or both to and from the CocoBase tool suite

Because Fig. 2 of Mullins relates to the system described in the '197 patent (See paragraph [0044]), and Figs. 3 and 4 described in paragraphs [0045] and [0046] include "additional components," these portions are new matter with respect to the '197 patent. As such, the Examiner's reliance on the '197 patent through parent application 60/249,418 to reject claims 1-30 is improper. In view of the above, the cited portions of Mullins do not receive priority of the parent application, and thus are unavailable as prior art under 35 U.S.C. § 102(e).

b. The Examiner has not Referenced Particular Portions of Parent Application 60/249,418.

If the Examiner relies upon the disclosure of the 60/249,418 application to reject claims 1-30, the Office Action does not articulate which portions allegedly relate to these claims. That is, should the Examiner maintain that the cited portions

of Mullins are supported by the disclosure of the '418 application, the Examiner is required to articulate this support in a manner that offers Applicants the opportunity to analyze the reference to determine at least the substance of any arguments and whether the relied upon portions in Mullins are indeed supported by the parent application. The Examiner has not met this burden. Instead, the Examiner merely states that the cited portions in Mullins are not new matter "as applied to applicant's invention." Considering the size of the 60/249,418 application and attached Appendix, Applicants respectfully request that the Examiner point out the portions of the 60/249,418 application that provide the asserted support for the subject matter relied upon in Mullins.

In light of the foregoing arguments, Applicants submit that Mullins is not eligible as prior art under 35 U.S.C. § 102(e) because the filing date of that reference is after the filing date of Applicants' application and the reference claims priority of the '418 application as a CIP. Although Applicants appreciate the Examiner providing a copy of the 60/249,418 application, the Examiner has not shown support for priority to the parent application with respect to the cited portions of Mullins. As such, the rejection of claims 1-30 under 35 U.S.C. §§ 102(e) and 103(a) should be withdrawn.

II. The Finality of the Current Office Action

Based on the above arguments, should the Examiner maintain that claims 1-30 are rejected in view of Mullins based on subject matter disclosed in the parent application no. 60/249,418, Applicants request that the Finality of the current Office Action be withdrawn. A non-final office action is warranted because Applicants have

not been afforded an opportunity to analyze the newly cited reference in light of the Examiner's new positions. The Examiner has recently provided a copy of the parent application for consideration by Applicants. As explained above, there are still unresolved issues regarding the priority of Mullins in view of the '418 application. Accordingly, Applicants request that the finality of the Office Action be withdrawn.

III. The Rejection of Claims 1-30 in view of Mullins

Notwithstanding the above issues, Applicants address the rejection of claims 1-30 in view of Mullins. The following arguments do not waive Applicants position set forth in Section I of this response, but instead is provided as an effort to streamline prosecution of this application should the Examiner maintain the position, and provide adequate, support that Mullins is indeed eligible as prior art under 35 U.S.C. §§ 102 and 103.

a. The Rejection of Claims 1, 3-20 under 35 U.S.C. § 102(e)

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(e), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the...claim." See M.P.E.P. § 2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th Ed. 2001), p. 2100-69.

Based on the following remarks, Applicants traverse the rejection of claims 1 and 3-30 under 35 U.S.C. § 102(e).

The Examiner asserts that Mullins teaches:

receiving database record information at a client computer system from a database server; See [0045]; [0046];

modifying the database record information at said client computer system using a first computer programming language; See [0045]; [0046];

transmitting the database record information with modifications to an application server; See [0045]; [0046];

converting the modifications, at the application server, to calls of a second computer programming language of a computer application; See [0042]; [0045]; and [0046]; and

executing the second computer language programming calls to invoke functions of the computer application to cause database record changes at said database server that correspond to the modifications to the database record information; See [0042]; [0045]; [0046]; [0213].

See Office Action, page 4. Applicants respectfully disagree with the Examiner's interpretation of Mullins. Contrary to the Examiner's position, Mullins does not teach modifying a database record received from a database server using a first computer programming language. Instead, Mullins merely describes a system that allows an object application to receive information from a data store through an abstract layer that performs conversions between object and non-object views. Indeed, the text cited by the Examiner (i.e., paragraphs [0042], [0045], and [0046]) does not mention modifying any database records. At most, paragraph [0042] makes a reference to changing mapping information and metadata, which is not the same as modifying database record information received from a database server.

Further, the Examiner is incorrect in asserting that Mullins discloses transmitting the database record information with modification to an application server and converting the modifications to calls of a second computer programming language. As explained, the passages cited by the Examiner do not support the Examiner's assertions. It also follows that the reference fails to teach executing the second computer language programming calls to invoke functions of the computer application to cause database record changes at the database server corresponding to the modifications to the database record information.

Moreover, Applicants can find no teaching in Mullins regarding these processes. The text in paragraph [0213] of Mullins (cited by the Examiner) merely describes the use of XML data sets to substantiate objects in a second XML document. These processes are not related to modifying, transmitting, and converting database record information, as asserted by the Examiner and explained above. The only modifications that Mullins discloses is associated with the mapping information and tables, including XML format maps, used to perform the conversions between object and non-object information.

In light of the above remarks, Mullins does not support the rejection of claim 1 under 35 U.S.C. § 102(e). Accordingly, Applicants request that the rejection of this claim be withdrawn and the claim allowed.

Claims 3-9 depend from claim 1. As explained, the cited art does not support the rejection of claim 1. Accordingly, it follows that the cited art also does not support the rejection of claims 3-30, and Applicants request that the rejection of these claims be withdrawn and the claims allowed.

Moreover, Mullins does not teach transmitting to the application server a list of changes made to the database record information, as asserted by the Examiner. Instead, paragraph [0116] (cited by the Examiner) merely describes how imported maps may be manually edited if they do not reflect the physical structure of the underlying database. Also, the cited paragraph mentions how XML format maps may be edited before importation. Although Mullins mentions that the edits consist of changing column names, table names, and schema names, such changes have no relationship to modifying database record information at the client computer system. Instead, the mentioned changes refer to the format maps used by Mullins in facilitating the conversion processes mentioned above. Further, Mullins does not mention transmitting a list of any changes to these maps or any other type of information. Accordingly, not only does Mullins fail to teach modifying database record information, the reference cannot and does not teach or suggest transmitting a list of changes made to this information. Accordingly, the reference fails to support the rejection of claim 3, and therefore the rejection should be withdrawn.

Further, it follows that Mullins does not teach an application server that determines the changes that have been made to the database record information from the list and converts the changes to function that cause modifications to a database record of the database server, as asserted by the Examiner. Accordingly, Mullins does not support the rejection of claim 4 and therefore the rejection should be withdrawn.

Also, in rejecting claim 5, the Examiner relies on paragraphs [0134-0136] to assert that the database record information represents at least a subset of a table of

the database server and inserting in the subset of the table when modifying the database record information. Applicants disagree. These passages in Mullins describe subprocess associated with importing maps from XML repositories using “CocoBase,” and customizing attributes to be generated in Java code by “CocoAdmin.” See heading before paragraphs [0114] and [0135] and paragraphs [0114]-[0136]. Here, Mullins merely teaches the processes associated with modifying conversion maps and attributes associated with these maps. Nothing in Mullins describes inserting an element in a subset of a table represented by database record information, as asserted by the Examiner. Accordingly, Mullins does not support the rejection of claim 5 and therefore the rejection should be withdrawn.

The Examiner relies on the same paragraphs in Mullins, as well as paragraph [0133], to support the assertion that the reference teaches:

an EJB object that corresponds to the table subset modified at said client computer system; See [0133-0136]; and

creating a map to enable inserts into a table of said database server that corresponds to said step of inserting at said client computer system; See [0133-0136],

identifying all create methods of said EJB object and of sub-objects of said EJB object; See [0133-0136];

determining which columns of tables of said database correspond to arguments of identified create methods; See [0133-0136]; and

wherein said step of creating said map comprises mapping said columns to arguments of the create methods that correspond to said columns; See [0133-0136],

[determining], at said application server, the location of the insert into said subset of said table and mapping the element inserted into said subset to an argument of the

identified create method that is operative to cause said element to be inserted into said table of said database server; See [0133-0136], and

executing the identified create method, at the application server, to cause the element to be inserted in said table of said database; See [0133-0136].

See Office Action, pages 5-6. As explained above in connection with the rejection of claims 4 and 5, Mullins merely teaches processes associated with modifying conversion maps and attributes associated with these maps. Nothing in Mullins (including paragraphs [0133-0136]) describes inserting an element in a subset of a table represented by database record information, as asserted by the Examiner. Accordingly, Mullins does not support the rejection of claims 6-9 and therefore the rejection of these claims should be withdrawn.

Also, the Examiner relies on the above noted paragraphs of Mullins to assert that the reference teaches:

receiving, at an application server, a set of commands from a client computer system to modify a database record of a database server; See [0133-0136];

identifying certain application instructions of an application, at said application server, that are operative to insert elements into a database record; See [0133-0136];

enabling said certain application instructions to be correlated to certain commands received from said client computer system that indicate the insertion of an element into said database record; See [0133-0136];

executing selected certain application instructions that correspond to said certain commands, wherein execution of said selected certain application instructions cause the invocation of a database call to insert elements into said database record corresponding to said certain commands; See [0133-0136].

See *Office Action*, pages 6 and 7. As explained above in connection with the rejection of claims 1 and 3-9, Mullins does not support the Examiner's assertions because the reference does not teach, among other things, receiving at an application server, a set of commands to modify a database record of a database server. Instead, the reference merely describes changing format maps that facilitate the conversions of object and non-object data. Thus, it follows that the reference also does not teach the steps of identifying, enabling, and executing, as asserted by the Examiner and set forth above. Accordingly, the reference does not support the rejection of claim 10 under 35 U.S.C. § 102(e) and therefore should be withdrawn and the claim allowed.

Claims 11-19 depend from claim 10. As explained, the cited art does not support the rejection of claim 10. Accordingly, it follows that the cited art also does not support the rejection of claims 11-19, and Applicants request that the rejection of these claims be withdrawn and the claims allowed.

Applicants also traverse the Examiner's assertions that Mullins teaches:

identifying first level software components of an application on an application server, that contain sub-level software components, said sub-level software components for accessing data input fields of a database; See [0133-0136];

exposing the first level software components in association with operations of sub-level software components for accessing the information contained in the data input fields; See [0133-0136];

mapping modification commands received, at the application server, from a client computer system to the identified first level and sub-level software components that correspond to the modification commands; See [0133-0136]; and

executing the identified software components to update said database in accordance with the modifications received from the client computer system; See [0133-0136].

See *Office Action*, page 9. As explained, paragraphs [0133-0136] of Mullins merely describes processes associated with modifying maps associated with the conversion processes performed by Mullins. "Attributes that are to be generated into the Javacode by CocoAdmin can be customized through the code generation screen of CocoAdmin, which is displayed when a map is selected from the wizard connections tree." See e.g., Mullins, paragraph [0135]. Accordingly, Mullins does not support the contentions presented above, and thus cannot support the rejection of claim 20. Therefore, Applicants respectfully request that the rejection of this claim be withdrawn and the claim allowed.

Claims 21-24 depend from claim 20. As explained, the cited art does not support the rejection of claim 20. Accordingly, it follows that the cited art also does not support the rejection of claims 21-24, and Applicants request that the rejection of these claims be withdrawn and the claims allowed.

Applicants also traverse the Examiner's assertion that Mullins teaches:

receiving, at an application server, the result of a query request as modified by a client computer system; See [0142]; [0145]; [0146];

determining, at the application server, the modifications made to the result of the query request; See [0142]; [0145]; [0146];

converting, at said application server, the modifications from a first programming language into a general computer programming language command for accessing a database; See [0142]; [0145]; [0146]; and

executing said general programming language command to produce a database protocol command to modify a database record to correspond to the query request as modified by the client computer system; See [0142]; [0145]; [0146].

See Office Action, pages 10-11. Contrary to the Examiner's position, paragraphs [0142] and [0145-0146] of Mullins do not teach or even suggest the above cited steps. Instead, these passages merely describe the components of Figs. 3 and 4 and make reference to changing mapping information and metadata. These processes are not the same as modifying a query, much less converting the modifications a first programming language into a general computer programming language command for accessing a database or executing said general programming language command to produce a database protocol command to modify a database record to correspond to the query request as modified by the client computer system, as asserted by the Examiner. Accordingly, Mullins does not support the rejection of claim 25, and therefore Applicants request that the rejection of this claim under 35 U.S.C. § 102(e) be withdrawn and the claim allowed.

Claims 26-30 depend from claim 25. As explained, the cited art does not support the rejection of claim 25. Accordingly, it follows that the cited art also does not support the rejection of claims 26-30, and Applicants request that the rejection of these claims be withdrawn and the claims allowed.

b. The Rejection of Claim 2 under 35 U.S.C. § 103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference or references, taken alone or combined, must teach

or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02. Moreover, each of these requirements must “be found in the prior art, and not based on applicant’s disclosure.” M.P.E.P. § 2143.

As admitted by the Examiner, Mullins fails to teach “determining when a user has completed making changes to said database record information at said client computer system.” The Examiner, however, asserts that Sidles makes up for the deficiencies of Mullins. *See Office Action, pages 12-13*. Applicants respectfully disagree with the Examiner for the following reasons.

First, the Examiner has failed to designate the particular part relied upon in Sidles. 37 C.F.R. § 1.104(c)(2) states that “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.” Here, the Examiner did not even cite to a portion of Sidles in support of the assertions set forth in the Office Action. Accordingly, Applicants submit the rejection of this claim is improper and should be withdrawn.

Second, Sidles merely describes processes associated with on-line form submissions. Although these processes may include making changes to entered information on a web page, the reference does not support the Examiner’s assertion that the processes include determining when a user has completed making changes

to database record information at a client computer system. In fact, the reference merely describes a form fill proxy process that sends incomplete forms back to a user's browser when no prior copy of the form exists. See Sidles, paragraph [0105]. These on-line processes are not associated with modifying database record information as asserted above.

Further, there is no motivation to combine the on-line form filling processes taught by Sidles with the tiered conversion processes disclosed by Mullins. Nothing in either reference suggests Mullins has a need or would benefit from a proxy process that allows a user's browser to receive incomplete web-based forms.

Accordingly, the cited art does not support the rejection of claim 2, and as a result, the Examiner has not presented a prima facie case of obviousness. Therefore, Applicants respectfully request that the rejection of this claim be withdrawn and the claim allowed.

IV. Conclusion

Applicants respectfully requests that this response under 37 C.F.R. § 1.116 be considered by the Examiner. Applicants submit that the positions taken by the Examiner regarding the priority of Mullins warrants removal of the Finality of the Office Action. Further, in view of the foregoing remarks, Applicants submit that this claimed invention, is neither anticipated nor rendered obvious in view of the cited art. Applicant therefore request the Examiner's reconsideration and reexamination of the application and the timely allowance of claims 1-30.

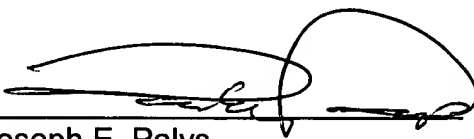
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: November 23, 2004

By: _____


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